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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,183	10/09/2003	Timothy B. Barnum	8049.0789-01	7882
22852	7590	12/15/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BUTLER, MICHAEL E	
			ART UNIT 3653	PAPER NUMBER

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/681,183	<b>Applicant(s)</b> BARNUM ET AL.	
	<b>Examiner</b> Michael Butler	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 11-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 28-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                             |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08262004</u> <i>8.6.2005</i> | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim of priority to application 09/849994 filed 5/8/2001 which claims priority to provisional application 60/250146 filed 12/1/2000.

### ***Drawings***

2. The drawings are acceptable

### ***Election/Restriction***

3. Applicant's election of invention II with traverse of the restriction requirement mailed 4/4/2005 is acknowledged and made final.
4. Claims 11-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected, there being no allowable generic or linking claim.
5. The applicant argues the restriction requirement ought be withdrawn for a lack of burden. Reverters comprise a distinct element not normally found in most sorters requiring separate search and consideration. The integrated postal system is capable of performing moving mail independent of verifying postage.

No common prior art anticipating the group I and II claims was noticed in the search of the Group II claims, further evidencing distinction between groups I and II.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

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- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 28 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by

Syvatsky et al. (6019364) which discloses all the claimed elements including:

(Re: cl 28) verifying and canceling postage by the postage verifier (c5 L 32-45) ;  
positioning mail pieces output from the postage verifier in a same configuration in a single file line ( c1 L 10-25 with c2 L 25-32) ;  
directing the mail pieces up the upward module (c5 L1-55);  
directing the mail pieces through the overhead transport (c5 L1-55);  
directing the mail pieces down the downward module to a mail sorter (c5 L 1-17;c7 L 1-39);  
and sorting the mail based on destination (c5 L 45-56);  
(Re: cl 34) (32) further including selectively feeding mail into the mail sorter from a feeder and the second mail carrying module (c5 L1-55)  
(Re: cl 35) (28) wherein directing mail pieces up an upward module comprises directing mail of a specific type up the upward module and directing mail pieces of a different type into one or more stackers (c5 L1-55)  
(Re: cl 36) (28) wherein directing mail pieces up an upward module comprises diverting mail to one or more stackers when an error occurs downline from the upward module (c5 L1-55)  
(Re: cl 37) (28) wherein directing mail pieces down a downward module includes directing mail pieces into one or more stackers when the mail sorter is unavailable (c5 L1-55).

8. Claims 28 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Weeks

et al. 5363971 which discloses all the claimed elements including:

(Re: cl 28) verifying and canceling postage by the postage verifier ;  
positioning mail pieces output from the postage verifier in a same configuration in a single file line (c5 L 28-44);  
directing the mail pieces up the upward module (c5 L 27-66);  
directing the mail pieces through the overhead transport (c5 L 27-66 );  
directing the mail pieces down the downward module to a mail sorter (c5 L 27-66);  
and sorting the mail based on destination (c5 L 51-66);  
(Re: cl 32) (28) wherein said optical character reader reviews address information on mail pieces and forwards bar code data to a database  
(Re: cl 33) (32) wherein the mail sorter obtains bar code data from the database for printing on mail pieces

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(Re: cl 34) (32) further including selectively feeding mail into the mail sorter from a feeder and the second mail carrying module (c5 L 27-66) ;  
(Re: cl 35) (28) wherein directing mail pieces up an upward module comprises directing mail of a specific type up the upward module and directing mail pieces of a different type into one or more stackers (c5 L 27-66) ;  
(Re: cl 36) (28) wherein directing mail pieces up an upward module comprises diverting mail to one or more stackers when an error occurs downline from the upward module (c5 L 27-66) ;  
(Re: cl 37) (28) wherein directing mail pieces down a downward module includes directing mail pieces into one or more stackers when the mail sorter is unavailable (c9 L 35-42).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim(s) 30 and 28 and 34-37 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Weeks in view of DeShe et al. 5293319 wherein the former discloses the elements previously discussed and the latter discloses any the elements not inherently taught by the former including:

(Re: cl 31) (28) wherein positioning mail pieces includes positioning mail pieces with a stamp leading (fig 4 & 1).

It would have been obvious for Weeks to orient the mail with the postage on the leading edge to read the postage and address labeling without the need to rotate the image as taught by DeShe et al. and come up with the instant invention.

11. Claim(s) 30 and 28 and 34-37 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Svyatsky et al. in view of DeShe et al. 5293319 wherein the former discloses the elements previously discussed and the latter discloses any the elements not inherently taught by the former including:

(Re: cl 31) (28) wherein positioning mail pieces includes positioning mail pieces with a stamp leading (fig 4 & 1).

It would have been obvious for Svyatsky et al. to orient the mail with the postage on the leading edge to read the postage and address labeling without the need to rotate the image as taught by Svyatsky et al.. and come up with the instant invention.

12. Claim(s) is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Weeks et al. in view of Sansone 6549892 wherein the former discloses all the claimed element except those taught by the latter including:

(Re: cl 29) further comprising: decoding address information on mail pieces that are determined not to include a bar code, sending bar code data corresponding to the decoded address and a mail piece identifier to a database ( c 3 L 46-67)

(Re: cl 30) wherein sorting further comprises determining whether mail pieces include a bar code; querying the database using a mail identifier to obtain bar code data for mail pieces without a bar code; printing obtained bar codes onto corresponding mail pieces; placing mail in stacks associated with a destination designated in bar codes on the mail pieces ( c3 L 46-67 & c4 L 20-36)

(Re: cl 32) wherein said optical character reader reviews address information on mail pieces and forwards bar code data to a database ( c3 L 46-67)

(Re: cl 33) wherein the mail sorter obtains bar code data from the database for printing on mail pieces ( c3 L 46-67).

It would have been obvious for to modify Weeks to verify address information from a database and print correct unique address bar codes because to reduce delivery errors with presort verification as taught by Sansone and come up with the instant invention as claimed. It would have been obvious for to modify Weeks to forward scanned address information to a

database and to update database collection for future corrections as taught by Sansone and come up with the instant invention as claimed.

13. Claim(s) 28-29 and 31-37 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Svyatsky et al. in view of Sansone wherein the former discloses all the claimed element except those taught by the latter including::

(Re: cl 29) further comprising: decoding address information on mail pieces that are determined not to include a bar code; sending bar code data corresponding to the decoded address and a mail piece identifier to a database ( c 3 L 46-67 )

(Re: cl 30) wherein sorting further comprises determining whether mail pieces include a bar code; querying the database using a mail identifier to obtain bar code data for mail pieces without a bar code; printing obtained bar codes onto corresponding mail pieces; placing mail in stacks associated with a destination designated in bar codes on the mail pieces ( c3 L 46-67 & c4 L 20-36)

(Re: cl 32) wherein said optical character reader reviews address information on mail pieces and forwards bar code data to a database ( c3 L 46-67)

(Re: cl 33) wherein the mail sorter obtains bar code data from the database for printing on mail pieces ( c3 L 46-67).

It would have been obvious for to modify Svyatsky et al. to verify address information from a database and print correct unique address bar codes because to reduce delivery errors with presort verification as taught by Sansone and come up with the instant invention as claimed. It would have been obvious for to modify Svyatsky et al. to forward scanned address information to a database and to update database collection for future corrections as taught by Sansone and come up with the instant invention as claimed.

14. Claim(s) 28-29 and 31-37 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Weeks et al. in view of Manduley et al. 5079714 wherein the former discloses all the claimed element except those taught by the latter including:

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(Re: cl 29) further comprising: decoding address information on mail pieces that are determined not to include a bar code; sending bar code data corresponding to the decoded address and a mail piece identifier to a database (c6 L 1-64)

(Re: cl 30) wherein sorting further comprises determining whether mail pieces include a bar code; querying the database using a mail identifier to obtain bar code data for mail pieces without a bar code (c6 L 1-64) ; printing obtained bar codes onto corresponding mail pieces; placing mail in stacks associated with a destination designated in bar codes on the mail pieces (c3 L 6-22)

(Re: cl 32) wherein said optical character reader reviews address information on mail pieces and forwards bar code data to a database (c6 L 1-64)

(Re: cl 33) wherein the mail sorter obtains bar code data from the database for printing on mail pieces (c3 L 6-22)

It would have been obvious for to modify Weeks to verify address information from a database and print correct unique address bar codes because to reduce delivery errors with presort verification as taught by Manduley et al. and come up with the instant invention as claimed. It would have been obvious for to modify Weeks to forward scanned address information to a database and to update database collection for future corrections as taught by Manduley et al. and come up with the instant invention as claimed.

15. Claim(s) 28-29 and 31-37 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Svyatsky et al. in view of Manduley et al. wherein the former discloses all the claimed element except those taught by the latter including::

(Re: cl 29) further comprising: decoding address information on mail pieces that are determined not to include a bar code; sending bar code data corresponding to the decoded address and a mail piece identifier to a database (c6 L 1-64)

(Re: cl 30) wherein sorting further comprises determining whether mail pieces include a bar code; querying the database using a mail identifier to obtain bar code data for mail pieces without a bar code (c6 L 1-64) ; printing obtained bar codes onto corresponding mail pieces; placing mail in stacks associated with a destination designated in bar codes on the mail pieces (c3 L 6-22)

(Re: cl 32) wherein said optical character reader reviews address information on mail pieces and forwards bar code data to a database (c6 L 1-64)

(Re: cl 33) wherein the mail sorter obtains bar code data from the database for printing on mail pieces (c3 L 6-22).



It would have been obvious for to modify Svyatsky et al. to verify address information from a database and print correct unique address bar codes because to reduce delivery errors with presort verification as taught by Manduley et al. and come up with the instant invention as claimed. It would have been obvious for to modify Svyatsky et al. to forward scanned address information to a database and to update database collection for future corrections as taught by Manduley et al. and come up with the instant invention as claimed.

***Conclusion***

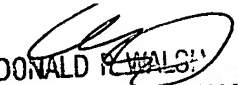
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (571) 272-6937.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (571) 272-6944. The fax numbers for the Group is (703) 305-7687/(703) 872-9306.

*Michael E. Butler*

Michael E. Butler  
Examiner

  
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